

Kabushinik Co. 535 U.S. 722 (2002) or any other cases related to the Doctrine of Equivalents.

Examiner's Interview

In a telephone interview with Examiner Forest Thompson on August 23, 2004, the Applicant agreed to amend the claims with the understanding that the amended claims would overcome all of the Examiner's rejections with respect to the Borland Paradox reference. Examiner Forest Thompson indicated that if the claims were amended as discussed the claims would be distinguished over Borland Paradox and both the Section 102 and Section 103 rejections would be immediately withdrawn. Examiner Thompson also indicated that a new search would then be conducted for other potential prior art based on the amended claims. **See Interview Summary mailed August 25, 2004.** The Applicant, in good faith and relying on the word of Examiner Thompson filed an amendment and response on September 9, 2004 along with an Request for Continuing Examination (RCE).

In the Office Action Mailed October 22, 2004, the Applicant was very surprised to see that Examiner's Akers ignored Examiner Thompson's written agreement with the Applicant and simply maintained the Section 102 and Section 103 rejections over the Borland Paradox reference and added a Section 101 rejection that doesn't make much sense based on current patent rules and case law. Examiner Akers also did not conduct a new search as was also indicated in

the interview summary by Examiner Thompson. The Applicant tried to reach Examiner Akers but Examiner Akers has returned none of the Applicant phone calls. The Applicant tried to reach the Examiner's Supervisor, but she returned none of the Applicant's phone calls.

The Applicant reminds Examiner Akers that the MPEP at §713.01 clearly states "Sometimes the examiner who conducted the interview is transferred to another Technology Center or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached."

Based on Examiner Akers comments, there was no indication of clear error on the part of Examiner Thompson, an experienced patent examiner who spent a long career at the patent office. Examiner Ackers also did not provide any knowledge of other prior art since Examiner Akers did not conduct another search as Examiner Thompson indicated would be done.

Examiner Ackers clearly failed to comply with MPEP at §713.01. Since Examiner Ackers has not complied with the patent rules, the Applicant includes a Notice of Appeal with this response and a request for an Oral Argument before the Patent Board of Appeals.

Examiner's Response to Arguments

The Examiner asserts that the "applicant amended the rejected claims solely with means of automation and distinct formats. Automating a known process is not a basis for novelty."

The Applicant traverses this rejection. First, by the Examiner own words, the Applicant amended the claims to include limitations other than automation. Second, the Applicant's process is not known. Claim 1 of the Applicant's invention includes the terms "unclaimed property". There is not a single issued U.S. Patent that includes these words in a claim or any other part of the patent. Thus, the Examiner's response to the Applicant's arguments make no sense to the Applicant.

Section 102 Rejection

The Examiner rejects claims 1-7, 10-11 and 25-26 under 35 U.S.C. 102(b) as being anticipated by "User's Guide, Borland Paradox for Windows;" Borland International, Inc.; v5.0; 1994 (hereinafter "Paradox").

Section 102 Response

The Applicant's response from the Response filed December 5, 2003, are incorporated herein by reference.

Section 103 Rejection

The Examiner asserts Claims 8-9 and 12-24 are rejected under U.S.C. §103(a) as being unpatentable over Paradox. The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

Section 103 Response

The Applicant's response from the Response filed December 5, 2003, are incorporated herein by reference.

Claims 8-9 and 12-18

The Applicant's response from the Response filed December 5, 2003, are incorporated herein by reference.

Claims 19-20

The Applicant's response from the Response filed December 5, 2003, are incorporated herein by reference.

Claims 21-24

The Applicant's response from the Response filed December 5, 2003, are incorporated herein by reference.

Section 101 Rejection

The Examiner rejected claims 2, 13 and 20 under 35 U.S.C. §101 as failing to provide a concrete useful and tangible result. The Applicant traverses this rejection.

Section 101 Response

Claims 2, 13 and 30 are dependent claims that include computer readable mediums. The Examiner is reminded that "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory since use of technology permits the function of the descriptive material to be realized. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data stored on a computer readable medium held statutory). See also MPEP §2106.

The Examiner is also reminded that "if a claim defines a useful machine or article of manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. *In re Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35.

The Examiner is further reminded that "if a claim defines a useful machine or manufacture by identifying the physical structure of the machine or

manufacture (i.e., a computer readable medium) in terms of its hardware or hardware and software combination it defines a statutory product. In re *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35.

The Examiner is finally reminded that "*office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result.* Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." See MPEP §2106.

Clearly the Examiner has not met this burden since he provided no explanation whatsoever as to why the claimed invention that includes method steps for acquiring unclaimed property information is devoid of any limitation to a practical application in the technical arts. The Examiner's only comment was one sentence rejecting claims 2, 13 and 20 under Section 101.

The Examiner also appears not to understand the holding of *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998) or *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). The Examiner is urged to actually read those cases and understand their holdings, the actually meaning applied to an invention providing a "useful,

concrete and tangible result." The Examiner is also urged to re-read Section 2106 of the MPEP that clear states what patentable subject matter for computer related inventions.

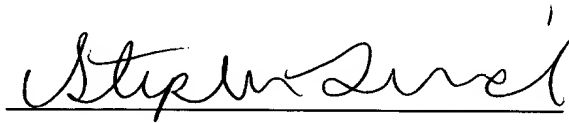
CONCLUSION

The Examiner has not correctly applied the patent rules or complied with the holdings of the Federal Courts. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §101, §102 and §103 rejections of claims 1-26 and pass all of the claims to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)

Dated: April 19, 2005

A handwritten signature in cursive script, appearing to read "Stephen Lesavich", is written over a horizontal line.

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